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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,704	12/22/2003	Tim Keith	2976-4037US1	8966
27123 7590 12/20/2007 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER SALMON, KATHERINE D	
			ART UNIT	PAPER NUMBER
			1634	
			NOTIFICATION DATE	DELIVERY MODE
			12/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com
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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/743,704

Applicant(s)

KEITH ET AL.

Examiner

Katherine Salmon

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9, 11-15, 21-27 and 32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Jehanne Sitton/
Primary Examiner

12/11/2007

Continuation of 3a: NOTE: The amendments to the claims are not being entered because the amendments to the claims raise new issues that would require further search and consideration. In Claims 1 and 9, the newly amended claim requires a nucleotide sequence comprising at least 500 consecutive nucleotides of SEQ ID NO. 2, 4, 6, 8, or 10 or the complement. The previously rejected claims did not state this limitation. Therefore the previously recited claims did not state a limitation for a nucleotide sequence comprising at least 50 consecutive nucleotides. The amendments to the claims recite limitations which raise new issues under 35 USC 102 which would require further search and consideration.

Continuation of 11: The reply does NOT place the application in condition for allowance because:

The reply traverses the rejection. (A) The reply asserts that one skilled in the art would know which nucleotides may flank the sequences of the instant invention (p. 9). The reply asserts that these sequences are known because the elected SEQ ID Nos are splice variants of each other (p. 9). The reply asserts that the claims have been amended to 500 consecutive nucleotides which are not described by GenBank Accession Number AI126846 (p. 12). The reply asserts that the rejection of Shankar et al. over the limitation "a complement" should be withdrawn because the claims have been amended to "the complement" (p. 13).

These arguments have been thoroughly reviewed but have not been found persuasive.

(A) Though the splice variants are known, the genus of nucleic acids which are encompassed by the claims is still very large. The genus includes homologues from other species, mutated species and polymorphic species. The instant specification has not provided guidance as to which nucleic acids would be encompassed by the claimed fragments. For example, GenBank Accession Number AI126846 (presented in the final as a rejection under 35 USC 102(a) in section 9) comprises 292 contiguous nucleotides of SEQ ID NO. 4.

(B) The limitations of "at least 500 nucleotides" and "the complement" are not recited in the pending claims in view of the non-entry of the after final amendment.


Katherine Salmon

Examiner
Art Unit 1634